

Remarks

Claims

In paper number 5, Examiner cited 5,644, 737 (Tuniman) as prior art anticipating claims 4-5, 7-8, 10-11, 13, 15-20.

Claim 4

Applicant agrees with Examiner that Tuniman anticipates claim 4 as drafted. Applicant thanks Examiner for his diligence. Claim 4 is canceled.

Tool groups (claims 5, 7-8, 10-11, 15-20)

Claims

Tool groups provide logical structuring of tools by related functionality. Because of their logical grouping, tool groups afford users faster access and use of tools within toolbars. Some groups of tools, and tools within groups, may be more or less used. A user might naturally want to quickly arrange tool groups to personal preference, or even have tools and tool groups arranged automatically by usage, without the cumbersome procedures described in the prior art.

Narrowing the width of a window with a toolbar in it may cause certain tools or groups of tools to become hidden. In the prior art, the user has no control over the tools which disappear in such an instance. The claimed technology overcomes that shortcoming.

Allowing users to optimize placement and usage of tool groups to maximize productivity in toolbar usage offers substantial convenience. Tool group manipulation is the subject of claims 5, 7-8, 10-11, 15-20.

Claims 5, 7-8, 10-11 go to altering the length of tool group exclusive of tool editing or altering toolbar length. Claims 15-18 go to rearranging tools within a group based upon usage frequency. Claim 19 goes to directly rearranging a group of tools within a toolbar. Claim 20 goes to merging two tool groups via direct manipulation of the groups.

Prior art

Tuniman fails to even mention tool groups, and so utterly fails to anticipate the aforementioned claims. Applicant respectfully submits that Examiner was mistaken in attributing Tuniman to even disclose separating tool groups within a toolbar; more particularly, the claimed manipulations were never mentioned.

Likewise, the 1993.08 IBM TDB previously cited by the Examiner describes editing a toolbar, adding and removing tools, without mention of tool groups.

6,133,915 (Arcuri) illustrates tool groups, but has nothing to say about them; tool addition and removal is the subject of the disclosure. Claims 5, 7-8, 10-11 explicitly exclude tool editing from the scope of the claims, and claims 15-20 are implicitly exclusive of tool editing.

Claims 5, 7-8, 10-11, 15-20 are unanticipated in the prior art cited, and there is no known prior art that anticipates these claims. Applicant recently searched for patent prior art that may anticipate these claims, and found none.

Claim 13 – merging toolbars

Claim

Claim 13 allows user manipulation to directly merge two toolbars into one. Coupled with the wrap-around and tool grouping features disclosed, direct toolbar merging facilitates user convenience in quickly optimizing toolbar construction to personal preference.

Prior art

Tuniman fails to even use the word “merge” in its disclosure. The Examiner’s cited passage in the disclosure, 10:34-67, is about auto-hiding and showing toolbars, not about merging them.

Applicant knows of no prior art that anticipates merging toolbars as claimed. None of the cited art to date appears to anticipate claim 13.

Reconsideration in the interest of compact prosecution

On December 29, 2003, applicant had faxed Examiner the substance of the remarks below with regard to prior art rejection as an informal communication, and on January 12, 2004, as scheduled beforehand, called to discuss the matter with the Examiner, in an attempt to traverse the rejections by persuading Examiner of the inapplicability of the cited prior art. Examiner refused to discuss the substantive issues with regard to prior art rejection, those prior art rejections being the only objection to allowance of the claims.

MPEP 706.02(b) states that "A rejection based on 35 U.S.C. 102(a) can be overcome by: (A) Persuasively arguing that the claims are patentably distinguishable from the prior art". Applicant cannot possibly overcome Examiner's rejections if Examiner does not allow meaningful communication.

MPEP 706.07 on the topic of Final Rejection quotes 37 CFR 1.113 as to the appropriateness of final rejection, and the responsibilities of the Examiner to provide the Applicant a thorough prior art search and a fair hearing.

"Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the

prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

“The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.”

As made clear in 37 CFR 1.113, both Applicant and Examiner have responsibilities in the prosecution of a patent application.

The claims under examination for which allowance is sought are mostly the original claims, only a few of which were modestly and not substantially amended from the original drafting. The two newly added claims after the first office action, claims 19 and 20, are about tool groups, and so any prior art relevant to the original claims would also apply to those new claims.

As 37 CFR 1.113 states, “the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied”. The Examiner has by now had two passes at finding anticipatory prior art to reject the claims, yet none has been found.

“The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.” 37 CFR 1.113

Prosecution of 09/707,194 developed to a clear solitary issue, that of prior art. If Examiner has met his responsibility of “thorough search”, he cannot reasonably sustain rejection of the claims on which allowance is sought on the basis of prior art. In the interest of compact prosecution, Examiner should allow the claims. As applicant has fulfilled his responsibilities of minimal amendment to the original claims, having reasonably pointed out the inapplicability of cited art, and the Examiner having had two opportunities to find relevant prior art to reject the

claims, and prior art remaining the only basis of rejection, applicant respectfully submits that Examiner has no redoubt to sustain the rejection of claims. Applicant having fulfilled his prosecution obligations, with no need for further claim amendment, he should not need to file a request for continued examination.

The Examiner sustaining his rejections at this time would necessitate an appeal by applicant. After appeal, Examiner would then have the opportunity to reopen prosecution, but such action would mock the prosecution process, as Applicant has met his prosecution obligations in good faith by drafting definite claims of narrow scope, with minimal claim amendment, and exercising due diligence in searching for prior art. If, in re-opening prosecution, Examiner would be admitting that he had not met his responsibilities as a patent examiner. After applicant filing for appeal, Examiner, hoping to avoid the embarrassment of an untenable position, would have to concoct a new ground of rejection to reopen prosecution. As Examiner's position in reopening prosecution would smack of artifice, applicant would then file a request for reinstatement of the appeal, as the only reasonable basis for rejection is prior art, and there is none.

Applicant should not have to suffer the delay and expense of the appeal process, nor be subject to a mockery of the prosecution process as described above.

Applicant respectfully traverses the rejections of claims 5, 7-8, 10-11, 13, 15-20. In the interest of compact prosecution, applicant respectfully submits that allowance of claims at this time is appropriate and fair.

Applicant thanks Examiner for his diligence in finding prior art. Applicant appreciates Examiner's reconsideration of his final rejection. Applicant welcomes further communication with Examiner. Applicant may be reached at (503) 524-8371.

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Respectfully submitted,



Gary Odom

15505 SW Bulrush Lane
Tigard, OR 97223

telephone: (503) 524-8371
fax: (775) 942-8525

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